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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,182	03/31/2004	Connie Marchek	DEP5291	7090
27777	7590	10/20/2006	EXAMINER	
PHILIP S. JOHNSON JOHNSON & JOHNSON ONE JOHNSON & JOHNSON PLAZA NEW BRUNSWICK, NJ 08933-7003				REIMERS, ANNETTE R
		ART UNIT		PAPER NUMBER
		3733		

DATE MAILED: 10/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/815,182	MARCHEK ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Annette R. Reimers	3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 24 July 2006.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) 9 and 17-33 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-8 and 10-16 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 31 March 2004 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>09/21/06</u> | 5) <input type="checkbox"/> Notice of Informal Patent Application |
|   | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-8 and 10-16 are rejected under 35 U.S.C. 102(b) as being anticipated by the Fiore (US Patent Number 3,815,585).

Fiore discloses a retractor blade assembly comprising a fixed blade, 15 having a tissue engaging segment extending along a longitudinal axis and an adjustable blade, 18, operatively coupled to the fixed blade and adjustable relative to the fixed blade along the longitudinal axis of the tissue engaging segment of the fixed blade, the adjustable blade includes a rectilinear flexible tab, 40, wherein the flexible tab is movable between a first position in which the tab is generally co-planar to the adjustable blade and a second position in which the tab is oriented generally transverse to the adjustable blade (see figure 1). The flexible tab is biased to the first position, and the flexible tab is configured to move away from the fixed blade when moved to the second position (see figure 1). In addition, a distal portion of the flexible tab is coupled to and formed from the adjustable blade, and the flexible tab is pivotable about the distal portion between the first and second positions (see figure 1). The flexible tab further includes a projection, 39, for engaging the fixed blade when the tab is in the first

position (see figure 1). In addition, the fixed blade includes a plurality of teeth stops, 42, for receiving the projection (see figure 1).

The flexible tab also includes a proximally facing instrument engagement surface to facilitate adjustment of the adjustable blade relative to the fixed blade (see figure 1). The adjustable blade includes an opening adjacent the instrument engagement surface to facilitate positioning of an instrument against the instrument engagement surface (see figure 1). Furthermore, the opening is sized to receive the distal end of an instrument for adjustment of the adjustable blade relative to the fixed blade and the opening is positioned proximal to the instrument engagement surface (see figure 1). Moreover, the instrument engagement surface is oriented generally perpendicular to the longitudinal axis of the fixed blade (see figure 1).

With regard to statement of intended use and other functional statements, they do not impose any structural limitations on the claims distinguishable over Fiore, which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Claims 1-8 and 10-16 are rejected under 35 U.S.C. 102(b) as being anticipated by the Pestka et al. (US Patent Number 3,650,266).

Pestka et al. disclose a retractor blade assembly comprising a fixed blade, 12 having a tissue engaging segment extending along a longitudinal axis and an adjustable blade, 16, operatively coupled to the fixed blade and adjustable relative to the fixed blade along the longitudinal axis of the tissue engaging segment of the fixed blade, the adjustable blade includes a rectilinear flexible tab, 18b, wherein the flexible tab is movable between a first position in which the tab is generally co-planar to the adjustable blade and a second position in which the tab is oriented generally transverse to the adjustable blade (see figures 1 and 2). The flexible tab is biased to the first position, and the flexible tab is configured to move away from the fixed blade when moved to the second position (see figures 1 and 2). In addition, a distal portion of the flexible tab is coupled to and formed from the adjustable blade, and the flexible tab is pivotable about the distal portion between the first and second positions (see figures 1 and 2). The flexible tab further includes a projection, 18d, for engaging the fixed blade when the tab is in the first position (see figures 1 and 2). In addition, the fixed blade includes a plurality of teeth stops, 14e, for receiving the projection (see figures 1 and 2).

The flexible tab also includes a proximally facing instrument engagement surface to facilitate adjustment of the adjustable blade relative to the fixed blade (see figure 1). The adjustable blade includes an opening adjacent the instrument engagement surface to facilitate positioning of an instrument against the instrument engagement surface (see figure 1). Furthermore, the opening is sized to receive the distal end of an

instrument for adjustment of the adjustable blade relative to the fixed blade and the opening is positioned proximal to the instrument engagement surface (see figure 1). Moreover, the instrument engagement surface is oriented generally perpendicular to the longitudinal axis of the fixed blade (see figure 1).

With regard to statement of intended use and other functional statements, they do not impose any structural limitations on the claims distinguishable over Pestka, which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

### ***Response to Arguments***

Applicant's arguments filed on July 24, 2006 have been fully considered, but they are not persuasive. Examiner respectfully disagrees with applicant regarding the Fiore and Pestka references. In response to applicant's arguments that the Fiore reference and the Pestka reference each fail to disclose that the adjustable blade is adjustable along the longitudinal axis of the fixed blade, it is noted that the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference.

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Kalman v. Kimberly Clark Corp., 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987). Regarding Fiore, with angular adjustment of the adjustable blade, 18, there is movement along the longitudinal axis of the fixed blade (see figure 1). Regarding Pestka, with pivotal movement of the adjustable blade, 16, there is movement along the longitudinal axis of the fixed blade (see figures 2 and 4). In regards to the recitation of a tissue engaging segment, a tissue engaging segment is very broad and any segment can be considered a tissue engaging segment.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Annette R. Reimers whose telephone number is (571) 272-7135. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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EDUARDO C. ROBERT  
SUPERVISORY PATENT EXAMINER